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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,710	02/11/2002	Jes Asmussen	MSU 4.1-572	5422
21036	7590	10/29/2004	EXAMINER	
MCLEOD & MOYNE, P.C. 2190 COMMONS PARKWAY OKEMOS, MI 48864			FULLER, ERIC B	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,710

Applicant(s)

ASMUSSEN ET AL.

Examiner

Eric B Fuller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 5,311,103).

Janesen teaches a method of roughening silicon substrates (column 6, lines 15-20) with diamond particles (column 6, line 30 - column 7, line 35). The nucleation density is within a range that would provide the claimed grain size (column 5, lines 30-50). Diamond is deposited on the substrate by plasma enhanced CVD (column 8, lines 15-29). The gasses, pressures, and temperatures are taught (column 7, line 55 - column 8, line 15). As the reference does not teach the inclusion of oxygen or nitrogen in the feed gases, and teaches that the amount of oxygen and nitrogen in the diamond film deposited should be minimized (column 11, lines 32-55), this reads on the gas being "essentially without oxygen or nitrogen" and the chamber being "essentially free from leaks of nitrogen or oxygen or mixtures thereof into the chamber". The reference fails to teach the inclusion of argon in the feed gas.

However, Desphandey teaches that argon has also been used with hydrogen and/or hydrocarbon gases to enhance the plasma volume chemistry in the region between the source and the substrate (column 5, lines 30-42). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use plasma in the gas feed of Janesen. By doing so, one would reap the benefits of enhanced plasma volume chemistry in the region between the source and the substrate. The combined references fail to teach performing the plasma CVD process in the claimed apparatus.

However, Asmussen teaches an apparatus for depositing diamond films on silicon substrates (abstract). The apparatus reads on the applicant's claims (column 12, lines 7-47). The benefits of using the apparatus is that it is economical to construct and reliable to use and produces excellent results (column 5, lines 1-5). Additionally, the tunable features allow for efficient use, as extra plasma requiring extra power is not produced. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the apparatus of Asmussen to perform the method of Janesen in view of Desphandey. By doing so, one would reap the benefits of efficient use, economical construction, reliable apparatus, and excellent results.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 5,311,103), as applied to claims 1 and 2 above, and further in view of Herb et al. (US 5,273,790).

Janesen, in view of Desphandey and Asmussen, teaches the limitations of claims 1 and 2, as shown above, but fails to teach using molybdenum as the substrate holder. However, Herb teaches that the holder should be fabricated from materials chosen to exclude carbon, in order to eliminate a potential uncontrollable source of carbon. Materials suitable for use include molybdenum (column 6, lines 61-65). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize molybdenum as the substrate holder. By doing so, one would reap the benefits of preventing uncontrollable sources of carbon.

Claims 1-5, 8-12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,585,668).

Janesen, in view of Desphandey, teach the limitations above, but fail to teach performing the plasma CVD process in the claimed apparatus.

However, Asmussen teaches an apparatus that reads on the applicant's claims (column 13, lines 5-44). The benefits of using the apparatus is that it is economical to construct and reliable to use and produces excellent results (column 6, lines 60-68). Additionally, the tunable features allow for efficient use, as extra plasma requiring extra power is not produced (column 10, lines 29-35). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the apparatus of Asmussen to perform the method of Janesen in view of Desphandey. By doing so,

one would reap the benefits of efficient use, economical construction, reliable apparatus, and excellent results.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,585,668), as applied to claims 1 and 2 above, and further in view of Herb et al. (US 5,273,790).

Janesen, in view of Desphandey and Asmussen, teaches the limitations of claims 1 and 2, as shown above, but fails to teach using molybdenum as the substrate holder. However, Herb teaches that the holder should be fabricated from materials chosen to exclude carbon, in order to eliminate a potential uncontrollable source of carbon. Materials suitable for use include molybdenum (column 6, lines 61-65). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize molybdenum as the substrate holder. By doing so, one would reap the benefits of preventing uncontrollable sources of carbon.

Claims 1-5, 8-12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,906,900).

Janesen, in view of Desphandey, teach the limitations above, but fail to teach performing the plasma CVD process in the claimed apparatus.

However, Asmussen teaches an apparatus that reads on the applicant's claims (column 10, lines 9-49). The benefits of using the apparatus is that it is economical to construct and reliable to use and produces excellent results (column 1, lines 59-68). Additionally, the tunable features allow for efficient use, as extra plasma requiring extra power is not produced. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the apparatus of Asmussen to perform the method of Janesen in view of Desphandey. By doing so, one would reap the benefits of efficient use, economical construction, reliable apparatus, and excellent results.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,906,900), as applied to claims 1 and 2 above, and further in view of Herb et al. (US 5,273,790).

Janesen, in view of Desphandey and Asmussen, teaches the limitations of claims 1 and 2, as shown above, but fails to teach using molybdenum as the substrate holder. However, Herb teaches that the holder should be fabricated from materials chosen to exclude carbon, in order to eliminate a potential uncontrollable source of carbon. Materials suitable for use include molybdenum (column 6, lines 61-65). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize molybdenum as the substrate holder. By doing so, one would reap the benefits of preventing uncontrollable sources of carbon.

Claims 1-5, 8-12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,727,293).

Janesen, in view of Desphandey, teach the limitations above, but fail to teach performing the plasma CVD process in the claimed apparatus.

However, Asmussen teaches an apparatus that reads on the applicant's claims (column 14, lines 5-44). The benefits of using the apparatus is that it is economical to construct and reliable to use and produces excellent results (column 1, lines 35-45). Additionally, the tunable features allow for efficient use, as extra plasma requiring extra power is not produced. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the apparatus of Asmussen to perform the method of Janesen in view of Desphandey. By doing so, one would reap the benefits of efficient use, economical construction, reliable apparatus, and excellent results.

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesen et al. (US 4,925,701), in view of Desphandey et al. (US 4,961,958), in further view of Asmussen et al. (US 4,727,293), as applied to claims 1 and 2 above, and further in view of Herb et al. (US 5,273,790).

Janesen, in view of Desphandey and Asmussen, teaches the limitations of claims 1 and 2, as shown above, but fails to teach using molybdenum as the substrate holder.

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However, Herb teaches that the holder should be fabricated from materials chosen to exclude carbon, in order to eliminate a potential uncontrollable source of carbon.

Materials suitable for use include molybdenum (column 6, lines 61-65). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize molybdenum as the substrate holder. By doing so, one would reap the benefits of preventing uncontrollable sources of carbon.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-12, 14-17, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 4 of U.S. Patent No. 4,585,668 in view of Janesen et al. (US 4,925,701) in view of Desphandey et al. (US 4,961,958).

Claims 1, 2, and 4 of the patent teaches the applicant's claimed method steps, but fails to claim depositing diamond. Janesen, in view of Desphandey teaches a

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diamond deposition process that requires plasma CVD. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to perform the diamond deposition of Janesen, in view of Desphandey, by the method of the U.S. Patent. By doing so, one would have a reasonable expectation of success, as the patent teaches a plasma deposition process and Janesen, in view of Desphandey, requires plasma deposition.

Claims 1-5, 8-12, 14-17, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-27 of U.S. Patent No. 4,585,668 in view of Janesen et al. (US 4,925,701) in view of Desphandey et al. (US 4,961,958).

Claims 22-27 of the patent teaches the applicant's claimed method steps, but fails to claim depositing diamond. Janesen, in view of Desphandey teaches a diamond deposition process that requires plasma CVD. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to perform the diamond deposition of Janesen, in view of Desphandey, by the method of the U.S. Patent. By doing so, one would have a reasonable expectation of success, as the patent teaches a plasma deposition process and Janesen, in view of Desphandey, requires plasma deposition.

Response to Arguments

Applicant argues that the limitations of the process being (1) essentially free from oxygen or nitrogen in the plasma, and (2) without leaching nitrogen or oxygen into the chamber of the apparatus are not taught by the prior art. This is not found persuasive. Janesen teaches a process in which there is no oxygen or nitrogen used in the process. Therefore, one of skill in the art would interpret this process as not having oxygen or nitrogen in the process. This reads on the limitations above.

Applicant argues that the plasma in Janesen is created without argon and that the process is performed in a different apparatus than that claimed. Applicant further argues that Desphandey performs the process in an apparatus than that claimed. Applicant also argues that Asmussen teaches the apparatus, but teaches a different process that differs from that claimed. These arguments are not convincing. These arguments address the references individually and point out differences that the examiner has all ready admitted to in the rejection. In the previous Office Action, the examiner combined these references in order to make up for these deficiencies. It has shown how it would have been obvious to combine these references and how the combination reads on the applicant's claims. The applicant has failed to argue the combination of references that was used in the rejection. The applicant has only addressed how each individual reference differs from the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Specifically to the present application, the examiner has shown that it would have been obvious to use argon in the plasma of Jenesen in order to reap the benefits of enhanced plasma volume chemistry in the region between the source and the substrate. It was further shown that it would have been obvious to perform the process in the apparatus of Asmussen in order to reap the benefits of efficient use, economical construction, reliable apparatus, and excellent results. This knowledge was all within the level of ordinary skill at the time of the claimed invention was made, and does not require knowledge gleaned only from the applicant's disclosure.

Applicant has failed to address the double patenting rejection presented in the previous Office Action. Therefore, the rejection has been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

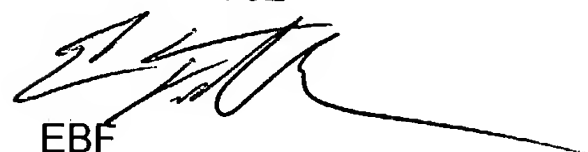
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

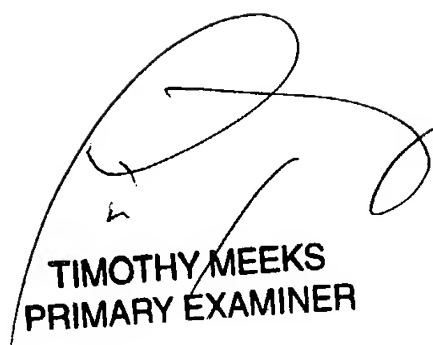
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EBF



TIMOTHY MEEKS
PRIMARY EXAMINER